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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/820,062

Applicant(s)

SMILEY ET AL.

Examiner

Andrew Y. Koenig

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-12,14-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-12, 14-20, 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3-7, 9-12, 14-20, and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 19 is objected to because of the following informalities:

Claim 19 appears to use an improper claim identifier of "(Currently Amended)" despite not having an amendment to the claim, and the examiner will treat claim 19 as "(Previously Presently)."

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17, 19, and 20 are directed to an apparatus comprising a readable medium capable to perform a method, which is merely functional descriptive material. Further, in the light of the specification, a readable medium can be delivered over wired and wireless transmissions (see specification: pg. 10, ll. 20-22), which equates to a signal. The examiner notes that a signal per se is non-statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 9-11, 14-15, 17, 20, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,778,181 to Hidary et al. (Hidary).

Regarding claim 1, Hidary teaches a method for distributing enhancement data for a television broadcast over a data network (fig. 2, col. 4, ll. 46-58). Hidary teaches receiving enhancement data corresponding to the television broadcast in a first format compatible with a first transport for a broadcast receiver not configured to decode enhancement data (col. 4, ll. 21-32, col. 4, ll. 40-54), converting the enhancement data into a second format compatible with a second transport different from a first delivery mechanism, wherein the second transport is the data network (col. 4, ll. 50-58), and providing said converted enhancement data to a client in accordance with the second transport (col. 4, ll. 54-58).

Regarding claim 4, Hidary teaches delivering codes (col. 4, ll. 54-58), which reads on pushing said converted enhancement data to the client.

Regarding claim 9, Hidary teaches a method for distributing enhancement data for a television broadcast to a viewer of the television broadcast (fig. 2, col. 4, ll. 46-58). Hidary teaches receiving enhancement data for the television broadcast over a first transport for a receiver not configured to decode enhancement data for presentation, said enhancement data having a first format in accordance with the first transport (col. 4, ll. 40-54), converting said enhancement data into a second format, different from the first format, for delivery of said converted enhancement data over a second transport different from the first transport, said second transport being a data network (col. 4, ll. 51-54), and providing said converted enhancement data to the viewer over the data network (col. 4, ll. 54-58).

Regarding claim 10, Hidary teaches the data network is the Internet col. 4, ll. 54-56).

Regarding claim 11, Hidary teaches delivering codes (col. 4, ll. 54-58), which reads on pushing said converted enhancement data to the client.

Regarding claim 14, Hidary teaches a method for distributing enhancement data for a television broadcast to a viewer of the television broadcast (fig. 2, col. 4, ll. 46-58). Hidary teaches a television broadcaster for broadcasting the television broadcast for a receiver not configured to decode enhancement data for presentation (col. 4, ll. 56-58), an enhancement data broadcaster for broadcasting said enhancement data over a first

transport in a first format in accordance with the first transport (col. 3, ll. 55-58), a central site for providing converted enhancement data to the viewer over a data network (fig. 2, server), wherein the central site comprises a receiver for receiver said broadcasted enhancement data over the first transport (col. 4, ll. 50-55), and a converter for converting said enhancement data into a second format different from the first format for delivery over the data network (col. 4, ll. 50-55).

Regarding claim 15, Hidary teaches the television broadcast also broadcasts said enhancement data (col. 3, ll. 45-60, col. 4, ll. 56-58).

Regarding claim 17, Hidary teaches an apparatus for distributing enhancement data for a television broadcast to a viewer of the television broadcast (fig. 2, col. 4, ll. 46-58). Hidary teaches a server (fig. 2), which inherently has a readable medium having instructions encoded thereon for execution by a processor capable of directing the processor to perform: receiving enhancement data corresponding to the television broadcast in a first format compatible with a first transport for a receiver not configured to decode enhancement data for presentation (col. 4, ll. 21-32, col. 4, ll. 40-54), converting the enhancement data into a second format compatible with a second transport different from a first delivery mechanism, wherein the second transport is the data network (col. 4, ll. 51-54), and providing said converted enhancement data to a client in accordance with the second transport (col. 4, ll. 54-58).

Regarding claim 20, Hidary teaches an apparatus for distributing enhancement data for a television broadcast to a viewer of the television broadcast (fig. 2, col. 4, ll. 46-58). Hidary teaches a server (fig. 2), which inherently has a readable medium having instructions encoded thereon for execution by a processor capable of directing the processor to perform: receiving enhancement data corresponding to the television broadcast in a first format compatible with a first transport for a broadcast receiver not configured to decode enhancement data (col. 4, ll. 21-32, col. 4, ll. 40-54), converting the enhancement data into a second format compatible with a second transport different from a first delivery mechanism, wherein the second transport is the data network (col. 4, ll. 50-58), and providing said converted enhancement data to a client in accordance with the second transport (col. 4, ll. 54-58).

Regarding claim 22, Hidary teaches an apparatus for distributing enhancement data for a television broadcast to a viewer of the television broadcast (fig. 2, col. 4, ll. 46-58). Hidary teaches a receiving means for receiving enhancement data corresponding to the television broadcast in a first format compatible with a first transport for a broadcast receiver not configured to decode enhancement data (col. 4, ll. 21-32, col. 4, ll. 40-54), converting means for converting the enhancement data into a second format compatible with a second transport different from a first delivery mechanism, wherein the second transport is the data network (col. 4, ll. 50-58), and providing means for providing said converted enhancement data to a client in accordance with the second transport (col. 4, ll. 54-58).

Regarding claim 23, Hidary teaches receiver means for receiver said broadcasted enhancement data over the first transport (col. 4, ll. 50-55), and converter means for converting said enhancement data into a second format different from the first format for delivery over the data network (col. 4, ll. 50-55).

Regarding claim 24, Hidary teaches delivering codes (col. 4, ll. 54-58), which reads on pushing said converted enhancement data to the client.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 5, 12, 16, 18, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,778,181 to Hidary et al. (Hidary) in view of Advanced Television Enhancement Forum Specification, draft, version 1.1r26 updated 2/2/99 (ATVEF).

Regarding claims 3 and 18, Hidary teaches converted enhancement data comprising web page content (col. 2-3, ll. 65-12), but is silent on using ATVEF. In analogous art, ATVEF teaches using triggers to enable creation of HTML-enhanced

television content that can be reliably broadcast across any network (see pg. 1, section: Status of This Document: paragraph 2), and further teaches different transport types (see pg. 10, section Transport Specifications, paragraph 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by using ATVEF type codes as taught by ATVEF in order to use the existing standards and maintaining compatibility with existing standards.

Regarding claims 5 and 25, Hidary teaches delivering codes (col. 4, ll. 54-58), but is silent on providing the enhancements according to the second format for pulling thereof by the client to the client. In analogous art, ATVEF teaches a Transport Type A, which provides the enhancements and pulling the data by a required return path (see pg. 10, section 2: Transport Specifications, paragraph 2, see also section 2.1), which reads on providing the enhancements according to the second format for pulling thereof by the client to the client. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by providing the enhancements according to the second format for pulling thereof by the client to the client as taught by ATVEF in order to provide for a robust system that permits various transfer methods, thereby enabling the system to adapt to different types of data.

Regarding claim 12, Hidary teaches delivering codes (col. 4, ll. 54-58), but is silent on providing a configured for the viewer to pull said converted enhancement data from the server over the data network according to the second format. In analogous art,

ATVEF teaches a Transport Type A, which provides the enhancements and pulling the data by a required return path (see pg. 10, section 2: Transport Specifications, paragraph 2, see also section 2.1), which reads on providing a configured for the viewer to pull said converted enhancement data from the server over the data network according to the second format. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by providing a configured for the viewer to pull said converted enhancement data from the server over the data network according to the second format as taught by ATVEF in order to provide for a robust system that permits various transfer methods, thereby enabling the system to adapt to different types of data.

Regarding claim 16, Hidary teaches the television broadcast comprising an audiovisual component comprising enhancement data (col. 4, ll. 40-50), wherein the receiver receives the television broadcast and extracts said enhancement data therefrom for conversion by the converter (col. 4, ll. 40-50). However, Hidary is silent on using ATVEF. In analogous art, ATVEF teaches using triggers to enable creation of HTML-enhanced television content that can be reliably broadcast across any network (see pg. 1, section: Status of This Document: paragraph 2), and further teaches different transport types (see pg. 10, section Transport Specifications, paragraph 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by using ATVEF type codes as taught by ATVEF

in order to use the existing standards and maintaining compatibility with existing standards.

8. Claims 6, 7, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,778,181 to Hidary et al. (Hidary) in view of U.S. Patent Application Publication 2002/0138852 to Reynolds et al. (Reynolds).

Regarding claim 6, Hidary teaches a method for distributing enhancement data for a television broadcast over a data network (fig. 2, col. 4, ll. 46-58). Hidary teaches receiving enhancement data corresponding to the television broadcast in a first format compatible with a first transport (col. 4, ll. 40-54), converting the enhancement data into a second format compatible with a second transport different from a first delivery mechanism, wherein the second transport is the data network (col. 4, ll. 51-54), providing said converted enhancement data to a client in accordance with the second transport (col. 4, ll. 54-56).

Hidary is silent on inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting. In analogous art, Reynolds teaches a media controller (308) selecting the appropriate streams (pg. 6, para. 0058), which reads on inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by inspecting a client profile associated with the client, and

determining the second format based at least in part on said inspecting as taught by Reynolds in order to provide the content that best matches the capabilities of the viewer's receiver.

Regarding claim 7, Hidary is silent on providing plural conversion formats including the second format, associating delivery prices with each of said plural formats; and selecting the second format of said plural formats based at least in part on said associated delivery prices and said inspecting the client profile. Reynolds teaches providing plural conversion formats and associating delivery prices with each of the plural formats, such as different audio and video formats, and selecting the second format based on least price and the client profile (pg. 4, para. 0030, 0041, pg. 6, para. 0055, 0058). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by providing plural conversion formats including the second format, associating delivery prices with each of said plural formats; and selecting the second format of said plural formats based at least in part on said associated delivery prices and said inspecting the client profile as taught by Reynolds in order to provide the content that best matches the capabilities of the viewer's receiver.

Regarding claim 19, Hidary teaches an apparatus for distributing enhancement data for a television broadcast to a viewer of the television broadcast (fig. 2, col. 4, ll. 46-58). Hidary teaches a server (fig. 2), which inherently has a readable medium having instructions encoded thereon for execution by a processor capable of directing

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the processor to perform: receiving enhancement data corresponding to the television broadcast in a first format compatible with a first transport (col. 4, ll. 40-54), converting the enhancement data into a second format compatible with a second transport different from a first delivery mechanism, wherein the second transport is the data network (col. 4, ll. 51-54), providing said converted enhancement data to a client in accordance with the second transport (col. 4, ll. 54-56).

Hidary is silent on inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting. In analogous art, Reynolds teaches a media controller (308) selecting the appropriate streams (pg. 6, para. 0058), which reads on inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary by inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting as taught by Reynolds in order to provide the content that best matches the capabilities of the viewer's receiver.

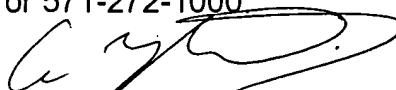
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Y Koenig
Primary Examiner
Art Unit 2623

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